



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/756,421	01/14/2004	Seong-jin Moon	1293.1073C3	2968

49455 7590 02/23/2007
STEIN, MCEWEN & BUI, LLP
1400 EYE STREET, NW
SUITE 300
WASHINGTON, DC 20005

EXAMINER

ONUAKU, CHRISTOPHER O

ART UNIT	PAPER NUMBER
----------	--------------

2621

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/756,421

Applicant(s)

MOON ET AL.

Examiner

Christopher Onuaku

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :11/15/06; 11/8/06; 10/26/06; 8/7/06.

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on 4/21/04 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Application No. 09/339,190, now US Patent No.6,757,476 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments

2. Applicant's arguments filed 11/22/06 have been fully considered but they are not persuasive.

Applicant argues that the examiner in rejecting claims 1-3 under 35 U.S.C. 101 fails to analyze the claims before concluding that the claims are non-functional descriptive material on a recording medium.

In response, examiner refers the applicant to claim 1, for example, which cites "A **recording medium** with respect to which data is transferred by a recording/reproducing apparatus, the **recording medium** comprising ... ", then the claim further goes on to cite different types of "**information**" recorded on the recording medium, which includes, for example, "... at least one still picture group **information** used by the apparatus for arranging ..."; "... at least one additional audio group **information** used by the apparatus for arranging ...". The "**information**" as recited in

Art Unit: 2621

claim 1 is a signal. And signals are intangible, which makes the claim non-statutory since this lacks any practical application within the recording medium per se that produces a useful, tangible and concrete result. That the "information" is "used for" performing a function simply satisfies an "intended use" clause. And, "intended use" in this case requires an external device to be actualized (see ANNEX IV of 35 U.S.C. 101 Interim Guideline of 3/2/06).

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-3 are rejected under 35 U.S.C. 101 because the claims are non-functional descriptive material recorded on recording medium, and therefore nonstatutory. "Nonfunctional descriptive material" includes but not limited to music, literary works and a compilation or mere arrangement of data. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement.

Claim 1, for example, cites "A **recording medium** with respect to which data is transferred by a recording/reproducing apparatus, the **recording medium** comprising ...", then the claim further goes on to cite different types of "**information**" recorded on the recording medium, which includes, for example, "... at least one still picture group **information** used by the apparatus for arranging ..."; "... at least one additional audio

Art Unit: 2621

group **information** used by the apparatus for arranging ...". The "**information**" as recited in claim 1 is a signal. And signals are intangible, which makes the claim non-statutory since this lacks any practical application within the recording medium per se that produces a useful, tangible and concrete result. That the "information" is "used for" performing a function simply satisfies an intended use clause. And, "intended use" in this case requires an external device to be actualized. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored in a computer-readable medium, in a computer, on an electromagnetic carrier signal does not make the claim statutory. (see ANNEX IV of 35 U.S.C 101 Interim Guideline of 3/2/06).

Conclusion


5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Onuaku whose telephone number is 571-272-7379. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Groody can be reached on 571-272-7950. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2621

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


COO
2/16/07


James J. Groody
Supervisory Patent Examiner
Art Unit 262 2621